

Applicants : Butts, *et al.*
Appl. No. : 10/614,537
Examiner : Hussein A. El Chantli
Docket No. : 700693-4022

REMARKS

Claims 1-29 are pending in the present application.

Claims 1-4 and 6-29 have been rejected as being anticipated by U.S. Patent No. 6,574,239 to Dowling *et al.* ("Dowling").

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Dowling in view of alleged knowledge in the art.

Claim 1, 21, 22, and 25 has been amended.

It is respectfully submitted that no new matter has been added.

Reconsideration of the application as amended herein is respectfully requested.

CLAIM REJECTIONS

Rejections under 35 U.S.C. §102(b)

The Office Action has rejected claims 1-4 and 6-29 under 35 U.S.C. §102(b) as being anticipated by Dowling. 05/27/2009 Office Action, p. 2, ¶ 2. Applicant respectfully traverses this rejection.

The Office Action states that Applicant's arguments in the previous response filed on March 09, 2009 are not persuasive because the term "**design verification system**" is a non-functional descriptive term that is given no patentable weight since the claim language does not define any structure or function. 05/27/2009 Office Action, p. 8, ¶ 9.

In response, claim 1 has been amended to recite "**the design verification system performs functional verification of at least two system elements including the first system element and a second system element.**" Claim 1, as amended, defines the function of the "**design verification system,**" therefore Applicant respectfully submits that the Examiner's

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ground of rejection that the term “**design verification system**” is a non-functional descriptive term is considered moot. Dowling’s communication system is neither intended to nor can perform this function of the “**design verification system**” because Dowling’s system is directed to a method for reconnecting a telephone modem with a reduced delay by reducing a time associated with retraining. See Dowling, Abstract.

Claim 1 is further amended to recite that “**the physical system element comprises one or more electronic components and the virtual system element comprises software models of the physical system element**.” Neither Dowling’s communication system nor any of Dowling’s system element has these features of claim 1 because it is not intended to perform the functions of the “**design verification system**.”

From the foregoing, Applicant respectfully submits that the term “**design verification system**” in claim 1 is a functional descriptive term and its structure as well as its function are defined, thus patentable weight must be given to the term “**design verification system**.”

The examiner must determine what is “analogous prior art” for the purpose of analyzing the obviousness of the subject matter at issue. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). MPEP § 2141.01(a).

Claim 1, as amended, recites functional and structural features of the “**design verification system**,” thus it became apparent that Dowling is not an “analogous prior art” for

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the purpose of examining the claimed subject matter because Dowling's invention is directed to a completely different field of endeavor (*i.e.*, telecommunication system) from the one of the claimed subject matter (*i.e.*, design verification system).

For these reasons, Applicant respectfully submits that claim 1 and claims 2-20 that depend from claim 1 are not anticipated under 35 U.S.C. §102(b) by Dowling.

Claim 21 is also amended to recite that "**the design verification system performs functional verification of at least two system elements including the physical system element and a virtual system element**" and that "**the physical system element comprises one or more electronic components and the virtual system element comprises software models of the physical system element.**" These features of claim 21 are not taught nor suggested by Dowling, therefore Applicants respectfully submit that claim 21 is not anticipated under 35 U.S.C. §102(b) by Dowling.

Claim 22 is also amended to recite that "**the design verification system performs functional verification of the first system element and the second system element**" and that "**the physical system element comprises one or more electronic components and the virtual system element comprises software models of the physical system element.**" These features of claim 22 are not taught nor suggested by Dowling, therefore Applicants respectfully submit that claim 22 and claims 23-24 that depend from claim 22 are not anticipated under 35 U.S.C. §102(b) by Dowling.

Claim 25 is also amended to recite that "**the design verification system performs functional verification of the first system element and the second system element**" and that "**the physical system element comprises one or more electronic components and the virtual**

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system element comprises software models of the physical system element.” These features of claim 25 are not taught nor suggested by Dowling, therefore Applicants respectfully submit that claim 25 and claims 26-29 that depend from claim 25 are not anticipated under 35 U.S.C. §102(b) by Dowling.

Rejections under 35 U.S.C. §103(a)

The Office Action has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Dowling. 05/17/09 Office Action, pp. 7-8, ¶ 3. Applicants respectfully traverse this rejection.

In rejecting claim 5, the Examiner stated that “Dowling does not explicitly teach that the standard coupling interface comprises an Open Core Protocol. Official notice is taken that it would have been obvious for one of ordinary skill in the art at the time of the invention to implement open core protocol in Dowling’s interface.” 05/17/09 Office Action, p. 8, ¶ 3.

Whether or not one of ordinary skill in the art is motivated to implement Open Core Protocol in Dowling’s invention, claim 5 is not rendered obvious by Dowling because claim 1, from which claim 5 depends, is allowable over Dowling for the reasons discussed above. Therefore Applicants respectfully submit that claim 5 is patentable under 35 U.S.C. §103(a) over Dowling.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application

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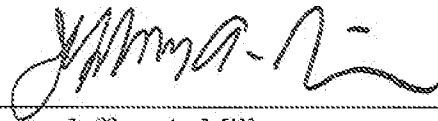
forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7660.

If there are any additional charges, please charge Deposit Account No. 15-0665.

Respectfully submitted,

Dated: August 27, 2009

By: _____



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